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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,229	11/30/2001	Yakov Kamen	ISURFTV152	6955
52940	7590	08/01/2006	EXAMINER	
TODD S. PARKHURST HOLLAND & KNIGHT LLP 131 S. DEARBORN STREET 30TH FLOOR CHICAGO, IL 60603			WILDER, PETER C	
			ART UNIT	PAPER NUMBER
			2623	
DATE MAILED: 08/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/008,229		KAMEN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Peter C. Wilder		2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/30/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-17 are original.

The rejection submitted on 1/30/2006 is withdrawn and new grounds of rejection are submitted.

#### ***Response to Arguments***

In response to the applicant's arguments of categories specifically the word "categories," the dictionary definition of "genre" is (See copy of attached definition), " a category of artistic, musical, or literary composition characterized by a particular style, form, or content." The examiner would agree that a broadcast program is not usually specifically musical or literary composition, but more a performance of actors/actresses composition. None-the-less genre is a way to categorize a composition by definition. In the reference Mori et al., in paragraph [0328] the word genre is used.

#### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 7, 10, 11, 13, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by McClard (U.S. 6438752 B1).

Referring to claim 1, McClard teaches a method comprising:

providing a first set of categories of broadcasted programs (Figure 2 element 34 teaches a provider and Column 4 lines 35-39 teaches providing genre categories for programs);

and adding a category from the first set to a second set of categories of broadcasted programs in response to one of selecting the category from the first set and tuning a broadcasted program viewing device, for a period of time at least equal to a first predetermined threshold, to at least one broadcasted program predetermined to be in the category from the first set (Column 4 lines 64-67 and Figure 3 element 54 teaches storing program category information in the memory and Column 5 lines 52-67 and Column 6 lines 1-9 teaches that when a program is watched for a period of time the program is added to a frequency watch list in memory 56 of Figure 3 and along with the program name the type/genre is added to memory 56 thus the category of a program is added from a first set of categories in memory 54 to a second set of data that includes categories in memory 56).

Referring to claim 4, depending on claim 1, McClard teaches an EPG system wherein the second unit (56 Fig. 3) is also to tune a broadcasted program viewing device (40 Fig. 3) to a channel on which a broadcasted program predetermined to be in a category from the second set will be broadcasted within a predetermined threshold of a current time (Column 5 lines 29-42 and Column 6 line 62 – Column 7 line 21).

Referring to claim 5, depending on claim 1, McClard teaches an EPG system wherein the second unit (56 Fig. 3) is also to tune a broadcasted program viewing device (40 Fig. 3), upon a singular pressing of a button (76 Fig 4), to a channel on which a broadcasted program predetermined to be in a category from the second set will be broadcasted within a predetermined threshold of a current time (Column 5 lines 29 – 42 and Column 6 line 62 – Column 7 line 21).

Referring to claim 7, see rejection of claim 1, note Figure 3 element 50. is a processor which requires instructions to function.

Referring to claim 10, depending on claim 7, see rejection of claim 4.

Referring to claim 11, depending on claim 7, see rejection of claim 5.

Referring to claim 13, see rejection of claim 1.

Referring to claim 16, depending on claim 13, see rejection of claim 4.

Referring to claim 17, depending on claim 13, see rejection of claim 5.

Claims 1, 7, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Arsenault et al. (U.S. 6971119 B1).

Referring to claim 1, Arsenault teaches a method comprising:

providing a first set of categories of broadcasted programs (Figure 1 and Figure 2 and Column 6 lines 30-46 and Column 7 lines 49-62 teach pre-transmission of data including categories; Column 11 lines 4-10 teach the receivers CPU element 74 in Figure 3 receiving the object data which includes categories);

and adding a category from the first set to a second set of categories of broadcasted programs in response to one of selecting the category from the first set and tuning a broadcasted program viewing device, for a period of time at least equal to a first predetermined threshold, to at least one broadcasted program predetermined to be in the category from the first set (Column 12 34-54 teaches storing the category of a program in a program selection history (second set); and Column 10 lines 44-67 and Column 11 lines 1-22 teach the conditional objects (which included category information ) being stored in guide database (first set) of the receiver).

Referring to claim 7, see rejection of claim 1, note Figure 3 element 50. is a processor which requires instructions to function.

Referring to claim 13, see rejection of claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 6, 8, 12, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClard (U.S. 6438752 B1) in view of Ohkura (U.S. 6128009).

Referring to claim 2, depending on claim 1, McClard fails to teach a second unit that is also to remove a category from the second set upon a selecting of the category from the second set.

In an analogous art, Ohkura discloses an EPG system wherein the second unit (24H Fig. 4) removes a category from a second set upon a selecting of the category from the second set (Column 28 lines 41-60).

At the time the invention was made it would have been obvious for one of ordinary skill in the art to modify the category set moving method McClard using the removal of a category method of Ohkura for the purpose of allowing the user to manually remove an undesirable category.

Referring to claim 6, depending on claim 1, McClard fails to teach verifying the adding of the category from the first set to the second set.

In an analogous art Ohkura teaches verifying the adding of the category from the first set to the second set (Column 32 lines 19-25 teaches checking to make sure categories have been moved from first set Figure 19 element 68 to the second set Figure 19 element 71).

At the time the invention was made it would have been obvious for one of ordinary skill in the art to modify the category set moving method McClard using the verification method of Ohkura for the purpose of notifying the user to hasten the registration (Column 32 lines 25-30, Ohkura).

Referring to claim 8, depending on claim 7, see rejection of claim 2.

Referring to claim 12, depending on claim 7, see rejection of claim 6.

Referring to claim 14, depending on claim 13, see rejection of claim 2.

Referring to claim 18, depending on claim 13, see rejection of claim 6.

Claims 3, 9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClard (U.S. 6438752 B1) in view of Mori et al. (US 2004/0210932 A1).

Dealing with claims 3, McClard fails to teach a second unit that is also to remove a category from the second set upon a broadcasted program viewing device not being



tuned, for a period of time at least equal to a second predetermined threshold, to at least one broadcasted program predetermined to be in the category from the second set.

In an analogous art, Mori teaches an EPG system wherein the second set (104 Fig 40 and favorite genre Fig 41.) upon a broadcasted program viewing device (107 Fig 40) not being tuned, for a period of time at least equal to a second predetermined threshold, to at least one broadcasted program predetermined to be in the category from the second set (The retention period is equal to the second predetermined threshold, in Mori's system once the device has reached the retention period which is the same as not being tuned for a predetermined threshold, the program with the favorite genre will be deleted from memory Paragraph [0328] lines 12-14).

It would have been obvious to one of ordinary skill in the art to modify McClard's method to include an automatic category removal method as taught by Mori, for the purpose of automatically removing categories that were added by one time user who tuned to a program that the regular user would not normally view.

Referring to claim 9, depending on claim 7, see rejection of claim 3.

Referring to claim 15, depending on claim 13, see rejection of claim 3.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter C. Wilder whose telephone number is 571-272-2826. The examiner can normally be reached on 8 AM - 4PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571)272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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